

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 39-61 are pending. As no claim is presently amended, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claims 39, 40, 43-47, 49-54, and 57-61 were rejected under 35 U.S.C. § 112, first paragraph; Claims 39, 40, 43, 44, 51-54, 57, and 58 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hodgson (U.S. Patent No. 3,645,835); Claims 45, 46, 50, and 60 were rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin (U.S. Patent No. 4,653,483); Claim 47 was rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin in view of Samuelsen et al. (WO 99/38929, hereinafter “Samuelsen”); Claim 49 was rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin in view of Hodgson; and Claims 59 and 61 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hodgson in view of Berglund et al. (U.S. Patent No. 4,310,509, hereinafter “Berglund”).

In response to the rejection under 35 U.S.C. § 112, first paragraph, it is noted that the relevant portion of Claim 39 recites that “the tape member in the stretched state is configured to have a resilient shrinkability larger than a tension of skin on the eyelid and smaller than a resilient shrinkability of the skin on the eyelid to form the fold in a direction perpendicular to the longitudinal direction of the tape member.”¹ Thus, this portion of Claim 39 covers following equation:

tension of skin < ***resilient shrinkability*** of tape member < ***resilient shrinkability*** of skin

Because the resilient shrinkability of the tape member is greater than the ***tension*** of the skin, when the stretched double eyelid forming article shrinks in the longitudinal direction, the skin of the eyelid also shrinks in the same direction by the same length. If the

¹ Independent Claims 45 and 51 recite a similar feature, Claim 45 being directed to a strip member and Claim 51 being directed to an elongate member.

resilient shrinkability of the tape member was not greater than the tension of the skin, the skin would not shrink at all when the tape member was attached (see sample 3 discussed in the Nojiri Declaration described below).

Because the *resilient shrinkability* of the skin is greater than the resilient shrinkability of tape member, the skin will fold in a direction perpendicular to the longitudinal direction of the tape member (i.e. the crease of the fold will extend longitudinally). If the resilient shrinkability of the skin was not greater than the resilient shrinkability of the tape member, as discussed in the previous response, then a large number of wrinkles (*not folds*) would be formed in the direction parallel to the longitudinal direction of the tape member (see sample 2 discussed in the Nojiri Declaration described below).

Accordingly, consistent with the description in the specification², because the resilient shrinkability of the tape member is within the claimed range, the tape member is able to form a fold on the eyelid without causing wrinkling. Therefore, it is respectfully requested that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

Turning now to the rejections under 35 U.S.C. § 103(a), Applicant respectfully requests reconsideration of these rejections and traverses these rejections, as discussed below.

The outstanding Office Action cites the same references from the previous Office Action to reject the claims. Accordingly, the arguments in the response filed on August 3, 2010, are incorporated by reference herein and re-asserted.

In section 43 of the Response to Arguments section, regarding the previous traversal of the rejection based on Hodgson, the Office Action notes that “applicant has not provided any factual evidence that would clearly show that the tape of Hodgson can not form a fold.” The Office Action also states that the part of Figure 3 reproduced on page 18 of the Office

² See the original specification, for example, at page 2, lines 2-6, at page 10, lines 18-25, and at page 11, line 16 to page 12, line 20, which describe how the tape (string, elongate) member forms a fold on the eyelid without causing wrinkles.

Action shows folds. Applicant respectfully disagrees. The portion of Figure 3 that the Office Action interprets as folds are actually wrinkles, not folds. Such wrinkles have creases that extend vertically such that the skin folds in a direction that is parallel, not perpendicular, to the longitudinal direction of the tape member. Thus, this portion of Figure 3 does not show a double eyelid. Instead, these wrinkles are what the claimed tape member is trying to prevent.

Additionally, as explained in the attached Declaration by the inventor, Hideyuki Nojiri, the tape of Hodgson has a resilient shrinkability that is higher than the resilient shrinkability of the eyelid skin. Thus, when applied to an examinee, the tape of Hodgson will shrink excessively. Because of the excessive shrinkage of the tape of Hodgson, the tape excessively bites into the eyelid (see Photo 5 of Nojiri Declaration), and unnatural deformations which cause a feeling of strangeness are formed on the eyelid. In addition, on the skin to which the tape is attached, a number of conspicuous vertical wrinkles are formed toward the tape (see Photo 5 and Photo 6 of Nojiri Declaration), and the examinee actually complained of an unpleasant feeling caused by a twitch.

Therefore, the tape of Hodgson has a resilient shrinkability that is higher than the resilient shrinkability of the skin. Accordingly, it is respectfully submitted that Hodgson does not disclose or suggest every feature recited in the independent claims. Thus, it is respectfully requested that the rejection of independent Claims 39 and 51, and all claims dependent thereon, as unpatentable over Hodgson be withdrawn.

Turning now to the rejection of Claim 45 based on Clavin, in section 48 of the Response to Arguments section, the Office Action notes that “while applicants argue that not all polyethylene have resilient shrinkability, applicants have not provided any evidence to show that the polyethylene of Clavin would not possess the resilient shrinkability as claimed.” In response, the Nojiri Declaration is hereby submitted.

As noted in the Nojiri Declaration, sample 3 corresponds to the adhesive strip 32 described in Clavin. Although the tape used for sample 3 is made of polyethylene, the resilient shrinkability of the tape is smaller than the tension of the skin of the eyelid, and hence the biting of the tape into the skin of the eyelid caused by the shrinkage was not found (Photo 7), and the double eyelid was also not formed (Photo 8).

Accordingly, as argued previously and as confirmed by the evidenced presented in the Nojiri Declaration, Clavin does not disclose or suggest that the adhesive strip 32 possesses the claimed resilient shrinkability.

Further, unlike the string member recited in Claim 45, the polyethylene described in Clavin is not required to have resilient shrinkability. Specifically, while the claimed string member has a specific resilient shrinkability, the adhesive strip 32 of Clavin can perform its intended functions without having the same resilient shrinkability. Therefore, the adhesive strip 32 of Clavin does not explicitly or inherently have the claimed resilient shrinkability. See MPEP 2112.

Accordingly, it is respectfully submitted that Clavin does not disclose or suggest every feature recited in independent Claim 45. Thus, it is respectfully requested that the rejection of Claim 45, and all claims dependent thereon, as unpatentable over Clavin be withdrawn.

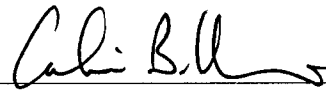
Further, regarding the position taken in section 11 on page 6 and section 23 on pages 11 and 12 of the Office Action, Applicant respectfully traverses this position. The Office Action states that “any reference disclosing a tape member that is resiliently stretchable (i.e. elastic) having...will read on the claims.” This position is incorrect and ignores positively claimed features. In view of the above discussion, it is again noted that the claimed tape, string, or elongate member has a range of resilient shrinkability that results in a structural configuration that the cited references do not disclose or suggest.

Turning now to the rejections of Claims 47, 49, 59, and 61, it is noted that these claims are dependent on independent Claims 39, 45, and 51. Accordingly, these claims are believed to be patentable for at least the reasons discussed above with respect to Claims 39, 45, and 51. Further, it is respectfully submitted that none of the secondary references (Samuelson, Hodgson, and Berglund) cure the above-noted deficiencies of Clavin and Hodgson. Thus, it is respectfully requested that the rejections of Claims 47, 49, 59, and 61 be withdrawn.

Consequently, in view of the above discussion, no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)

Colin B. Harris
Registration No. 58,969